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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/669,119
Filing Date: September 22, 2003
Appellant(s): KELLY ET AL.

Sabra-Anne R. Truesdale
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 June 2008 appealing from the Office action mailed 20 November 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

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(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appellant notes that the appeal in application 11/503,541 deals with substantially the same issues of law as this case. The examiner agrees.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 18 and 19 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. Furthermore, claims 18 and 19 are rejected under 35 U.S.C. 251

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because these are broadened claims but filed after 2 years of original patent issued which is improper.

Appellant's originally filed reissue application (10/006,939, now RE 38,428) was also a broadening reissue in that certain new claims were added that were of a different scope than the issued claims. The reissue declaration in the original reissue application (10/006,939) stated that the error being corrected by reissue was: " At least one error being relied upon as the basis for reissue is the failure to claim a method of avoiding deadlock in a computer system having a split-transaction bus and a single-envelope bus bridged by a bus bridge, the split-transaction bus and the single-envelope bus each having at least one master device and one slave device connected thereto, comprising: storing data from one or more accepted bus transactions; determining, prior to a request for a bus transaction from a requestor, if execution of such bus transaction would cause deadlock based on the stored data; and responsive to the determination that execution of the bus transaction would cause deadlock, sending a retry signal to the bus transaction requestor. " This error was corrected by the '939 application which reissued as RE38,428 E.

The present application was originally filed with a copy of the declaration from the '939 application and the claims were rejected based on the declaration being defective. Appellant has since filed a new declaration alleging a new set of errors. The new declaration also affirmatively states that this is a broadening reissue. However, the new errors being corrected are unrelated to the errors corrected in the '939 application. Appellant states in the declaration filed 7 January 2005 that the error being corrected in the present reissue is: "At least one error being relied upon as the basis for reissue is the failure to claim an arbitration circuit for a computer system, the arbitration circuit adapted to couple with a plurality of slave devices having transactions queued for execution, the arbitration circuit further adapted to signal any the

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plurality of slave devices to reorder their transactions without signaling a microprocessor of the computer system. Another error being relied upon as the basis for reissue is the failure to claim a computer-implemented method for reordering transactions, the method comprising: receiving and queuing within a slave device a plurality of transactions for execution; and signaling the slave device to reorder its transactions without signaling a microprocessor of the computer system that the transactions are being reordered. "

35 USC §251 related to the filing of reissue applications requires that "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." While it is true that appellant is allowed to file a continuation application of a broadening reissue which is itself a broadening reissue, the newly broadened claims should be broadened in a way that is covered under the original reissue declaration filed in the reissue parent which was filed within two years of issue of the original patent issuance. In this case the new broadening is not related in any way to what was covered by the original broadening reissue. In *In re Doll*, 419 F.2d 925, 164 USPQ 218 (CCPA 1970) the CCPA indicated that an issue to be determined in a case such as this one is whether the reissue oath/declaration originally filed with the reissue application is adequate to support the newly submitted claims. In that case the Court found that the original reissue oath met the requirements of Rule 1.175 in that it specifically identified the error in scope of claim coverage which the reissue application was seeking to correct and thus the original oath covered the newly submitted claims. However, in the instant application the new claims and their broadened aspect are not covered by the declaration filed in the '939 application.

To allow applicants to continue to file new, broader and unrelated reissue applications during the entire lifetime of the original patent as long as copendency of successive applications is maintained under 35 USC §120 cannot be correct since it would clearly subvert the strong

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public policy behind the limitations on broadening reissues set forth in the last paragraph of 35 USC §251. The reason or “error” for the filing of the current broadening reissue is totally unrelated to the facts that led to the filing of the first broadening reissue. If the facts that led to the filing of the first broadening reissue had not occurred, so that there would have been no need to file the first reissue application, there is no question that applicants would not be allowed to broaden the claims at this late date. Therefore, applicants are using the fortuitous and unrelated events which led to the first reissue as granting them a right they would not have had if the fortuitous and unrelated earlier events had not occurred. A reissued patent should not confer upon the patentee a procedural right that the patentee would not have had if the original patent had been kept. The purpose of the last paragraph of 35 USC §251 is to give the public notice of the patentee’s intention to enlarge the claims by filing a broadening reissue within two years as set forth in the statutory period. Requests for reissue are published in the Official Gazette, and the public is given a period to review the file to see the scope of the alleged errors before examination of the reissue application commences. The errors identified in the broadening reissue application become known to the public so that the public can have a sense of certainty as to the scope of patent rights the patentee will eventually have.

In this case, the first broadening reissue filed 30 November 2001 could not have apprised the public that patentee would seek an additional broadening reissue on 22 September 2003 based on facts totally unrelated to the facts on which the first reissue application was based. This attempt to bootstrap the filing date of each broadening reissue on the filing date of the previous one would leave the public at the mercy of patented claims being broadened for the lifetime of the original patent with no knowledge as to the manner in which further broadening will be sought. It is clearly against the strong public policy of the last paragraph of 35 USC §251 to allow the filing of reissue applications long after the two year period has expired

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based upon future facts which could not have been contemplated by anyone at the time of the filing of the first reissue application. The public's need to have a sense that the scope of a patent is fixed outweighs the patentee's need to continually redefine the scope of the claims to which he feels he is entitled. The patentee is given two years to determine whether a reissue application should be filed to enlarge the scope of the patent claims, and this period cannot be extended by use of 37 CFR §1.60 based upon facts which are unrelated to the facts which initially led to the filing of the broadening reissue application filed within the two year period.

(10) Response to Argument

I(a). Appellant argues that there is no requirement that the broadened claims in the continuation reissue application be covered by the declaration identifying what error was being corrected in the parent case (Brief, page 5). Appellant goes on to argue that the two-year requirement is met merely by apprising the public of applicant's intent to broaden the claims, and that "intent to broaden" does not require applicant to specify within the two year period the eventual scope of broadening. Appellant cites *In re Graff*, 111 F.3d 874, 877 (Fed. Cir. 1997).

The examiner first of all notes that the previous examiner's rejection has been expanded upon above, but the grounds of rejection and basic reasoning are still the same.

Graff does not include any holding that the mere filing of any broadening reissue within two years covers all future broadening in a continuation or succession of continuation reissue applications, nor does *Graff* indicate whether "intent to broaden" means intent to broaden in any possible way or intent to broaden in a particular way (i.e. the way indicated in the reissue declaration filed within two years), thus putting the public on notice with regard to how applicant intends to broaden his claims. In *Graff* the original reissue application was not a broadening

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reissue. The applicant in that case subsequently decided to file broadening amendments and at that time provided a declaration indicating that he had erroneously claimed “more or less” than he had a right to claim. The examiner rejected the broadened claims as being filed beyond the two year limit. Applicant decided to file a continuation reissue application with the broader claims in order to allow the original reissue application to pass to issue with drawing corrections only. The examiner again rejected the broadened claims in the continuation because they were filed beyond the two year limit. Mr. Graff argued that because he had filed for reissue prior to the two year limit that he should be allowed to present his broadened claims even though he was doing so after the two year limit expired. The Federal Circuit agreed with the Board that Mr. Graff could not file his broadened claims after the two year limit.

“We conclude that the reissue statute requires that proposals to broaden a patented invention must be brought to public notice within two years of patent issuance. The interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.” *In re Graff*, 42 USPQ 1474 (Fed. Cir. 1997).

In *Graff* the Court indicated that it is important that the public has notice with regard to the broadening within the two year limit.

“Mr. Graff proposes that it is sufficient if the public has notice that a reissue application had been filed within the two-year period, and that *Doll* charges the public with knowledge that broadening claims may be later added. On this case, the public had no notice that broadening was being sought until after the two-year period. **We discern no justification for imposing this degree of uncertainty upon the public. The reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights.**” (emphasis added) *Graff*, 1473-4.

The Federal Circuit’s reasoning here seems to support the examiner’s position in the instant application that the public has a right to know the extent of broadening to be applied to the original patent claims within the two year limit. Therefore, the broadened claims in the subsequent reissue applications should be broadened in a way in which the public was notified they would be broadened within the two year limit.

In this application the public was not put on notice with respect to the broadening of the claims sought in the present reissue application within the two year limit. The original reissue declaration identifies the error being corrected as: "The failure to claim or to further claim subject matter disclosed in the specification pertaining to a method for handling data transmitted on an isochronous channel using a linked list of buffers that includes the use of a condition field in each buffer." This error was corrected by the '939 (parent) application which reissued as RE38,428 E. Now applicant attempts to correct an entirely different error in this application. The latest reissue declaration (i.e., the reissue declaration of record), states: "At least one error being relied upon as the basis for reissue is the failure to claim an arbitration circuit for a computer system, the arbitration circuit adapted to couple with a plurality of slave devices having transactions queued for execution, the arbitration circuit further adapted to signal any the plurality of slave devices to reorder their transactions without signaling a microprocessor of the computer system. Another error being relied upon as the basis for reissue is the failure to claim a computer-implemented method for reordering transactions, the method comprising: receiving and queuing within a slave device a plurality of transactions for execution; and signaling the slave device to reorder its transactions without signaling a microprocessor of the computer system that the transactions are being reordered."

Regular continuation practice is primarily in place to allow applicants to "take" claims that have been found allowable by allowing the original application to pass to issue while continuing to prosecute, in a separate application, those claims that have been found to be not allowable. Here, appellant has already corrected the error originally identified as rendering the original patent wholly or partly inoperative or invalid in the first reissue application, an application which was filed within the two year limit set forth in the reissue statute for filing a broadening reissue application. However, appellant now seeks to broaden the claims in an entirely different manner

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outside the two year limit. No notice has been provided to the public of this broadening aspect within the two year limit.

In *In re Doll*, 419 F.2d 925, 164 USPQ 218 (CCPA 1970) there was a single application in question, not a continuation or chain of continuation applications. Of even greater importance, in *Doll*, the applicant filed a reissue declaration within the two year limit indicating that the application was a broadening reissue, and also explained in what way the application claims were to be broadened. Subsequent to the two year statutory limitation on broadening, the applicant filed in that same application a series of claims, some of which further broadened the claims. As noted above in the rejection, in *Doll* the CCPA indicated that an issue to be determined in a case such as this one is whether the reissue oath/declaration originally filed with the reissue application was adequate to support the newly submitted claims. In *Doll*, the Court found that the original reissue oath met the requirements of Rule 1.175 in that it specifically identified the error in scope of claim coverage which the reissue application was seeking to correct and thus the original oath covered the newly submitted claims. However, in the instant application the broadening aspects of the new claims are not recited in the declaration filed in the '939 (parent) application. For that reason, the examiner believes that the ultimate finding in *Doll* is not dispositive in this case, as has been argued in the related appeal (Application No. 11/503,541). The facts of the present appeal are different than the facts in *Doll*. In the instant application, the original declaration in the parent application does not inform the public that the general error sought to be corrected, that the patent claims are too narrow, was by reason of the claims being too limited in the manner now, for the first time, asserted by appellant in this reissue application. Specifically, the Federal Circuit stated in *Doll*:

“With respect to the rejection based on lack of an adequate reissue oath, it appears to us from the language employed by the board in its opinion that the affirmance of that rejection was based substantially on the view that the claims were barred by 35 USC 251. While Patent Office Rule 175 sets out requirements for reissue oaths, including that

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the applicant make a statement 'distinctly specifying the excess or insufficiency in the claims,' we do not see where there has been a lack of compliance therewith in this case. The original reissue application oath specifies:

None of the patent claims affords for the embodiment of Fig. 4 patent coverage of the scope possessed by claims 20-31, inclusive, which form part of the foregoing specification, nor were claims of comparable scope ever presented during the pendency of the original application on which said Letters Patent were granted.

If the claims of appeal are broader in scope than claims 20-31, originally presented, as all agree, it is clear that none of the patent claims afforded patent coverage of the scope of claims 32-35, 42 and 43 either. We are unable to perceive any other objections by the board to the oath in question. No particular defect has been singled out or commented upon by the board. On this record, we agree with appellant that the oath is adequate." *Doll*, 220 [Emphasis added.]

The above quoted language can serve to distinguish the present case from *Doll* in the following manner:

- 1) As already addressed to this point in the Answer, the reissue application was not "closed" in *Doll*. To the extent that the public was put on notice of the sort of broadening that was undertaken both before and after the additional broadening occurred, the public, having been warned of the pending reissue application, was able to follow the prosecution in *Doll* to its conclusion and thereby determine the true scope of the additional broadening.
- 2) In *Doll*, the later presented claims were found to be correcting the error identified in the reissue declaration, that the claims were too narrow, in the same manner by first presenting claims directed to an unclaimed embodiment and then presenting even broader claims to that embodiment. In the present appeal, the error described in the declaration filed within two years of the patent grant in no way relates to, and fails to inform the public of, the specific manner of broadening the patent claims presented in the present reissue application and first mentioned in any reissue declaration 11 June 2007 well beyond the 2-year period for broadening.

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Note that, at the time of *Doll*, all errors had to be specifically identified. Under today's practice, only one such error need be specifically identified, although more than one specific error may be identified. If a reissue declaration complies with 37 CFR 1.175 by identifying only one such error, and during the entire prosecution, a reissue application never supplies notice of other, unrelated areas of broadening by presenting claims thereto during the prosecution, then the public has no notice of those other areas of broadening. While the Office does publish notice of the filing of a continuation reissue application, why should an applicant be permitted to pursue broadening on a wholly different area of the disclosure by filing a continuation reissue application more than two years after the original patent issued, especially since the filing of a reissue application to broaden claims of a previously issued reissue patent is not permitted outside of the two year window running from the issue date of the original patent? This is particularly so on the present record, where there was only a single identified error, the avenue of broadening that is proposed in the present reissue application was not proposed in the parent(s) reissue applications(s), and even the original declaration filed in the present continuation reissue application did not identify the "different" error being corrected. How is that "Notice" to the public within two years of the issue date of the original patent regarding the error to be corrected in the present reissue application?

I(b). Appellant also notes that the rejection's reasoning is taken almost word for word from the unpublished and nonprecedential Board decision in *Ex parte Luu*, Appeal No. 96-1181, Application No. 08/188,764 (BPAI 1997) but that the reliance on this decision is misplaced (Brief page 4).

However, the decision in that case is a matter of public record and the Board's logic and reasoning in that case is applicable to the present application. The examiner has closely

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followed the reasoning in *Luu*. While it is true that in *Luu* the application in question was a reissue application of a reissue not a continuation filed under 35 USC 120, the Board stressed the important public policy reasons of providing notice to the public with regard to how the claims would be broadened within the two year limit set forth in the statute. To allow applicants to continue to file new broadening reissue applications that broaden in ways unrelated to the previously filed parent(s) reissue applications during the entire lifetime of the original patent as long as copendency of successive applications is maintained under 35 USC §120 cannot be correct since it would clearly subvert the strong public policy behind the limitations on broadening reissues set forth in the last paragraph of 35 USC §251. Unless an original reissue application is filed within two years of the original patent's issue date that identifies all of the specific errors by which the patent is defective because the original patent claims are too narrow, (or a plurality of reissue applications are filed within the two years, each directed to one such error), the two year bar on broadening is effectively circumvented, and 35 USC § 251 may as well be interpreted to permit a new, stand-alone reissue application to be filed outside of the two year period from the date of issue of an original patent to "further" broaden the claims of a previously reissued patent.

The reason or "error" for the filing of the current broadening reissue is totally unrelated to the facts that led to the filing of the first broadening reissue. If the facts that led to the filing of the first broadening reissue had not occurred, so that there would have been no need to file the first reissue application, there is no question that appellants would not be allowed to broaden the claims at this late date. Therefore, appellants are using the fortuitous and unrelated events which led to the first reissue as granting them a right they would not have had if the fortuitous and unrelated earlier events had not occurred. A reissued patent should not confer upon the patentee a legal right that the patentee would not have had if the original patent had been kept.

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Yet appellant did review the original patent, and did determine that the claims were too narrow for a specific reason. How is it that appellant did not identify the presently asserted errors in claim scope at that time?

The purpose of the last paragraph of 35 USC §251 is to give the public notice of the patentee's intention to enlarge the claims by filing a broadening reissue within two years as set forth in the statutory period. Requests for reissue are published in the Official Gazette, and the public is given a period to review the file to see the scope of the alleged errors before examination of the reissue application commences. The errors identified in the broadening reissue application become known to the public so that the public can have a sense of certainty as to the scope of patent rights the patentee will eventually have. Permitting a patentee to file a string of continuing reissue applications, which are not directed to continuing prosecution directed to one or more errors identified in the original patent within the two year period permitted for filing a broadening reissue application, but which are instead directed to different "broadening errors" which could have been identified by the patentee on the initial review of the original patent, should not be countenanced. The Board is requested to distinguish between conduct of this sort, and the proper filing of continuation reissue applications for the purpose of continuing unresolved prosecution in a parent application.

I(c). Appellant also argues that the MPEP directly contradicts the examiner's position in section 1412.03 (Brief pages 5-6).

The portions of MPEP 1412.03 emphasized by appellant are under Roman numeral IV. As noted above it is not clear what is meant by "intent to broaden" in the parent reissue application. There is no indication in the case law or the MPEP whether this means intent to broaden in any possible way or intent to broaden in a particular way (i.e. the way indicated in

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the reissue declaration filed within two years), thus putting the public on notice with regard to how applicant intends to broaden his claims.

II. Appellant argues that this application seeks to reissue the original patent and does not seek to reissue the parent reissue. (Brief pages 7-8)

The examiner agrees that this is correct. The previous examiner erred in arguing that this application was seeking to reissue the reissue. That was the fact pattern in *Luu* but does not apply to the present application. The previous argument/rationale set forth in the Final Rejection on this point has been withdrawn.

III. Appellant argues that the error arose without deceptive intention. (Brief pages 8-9)

The reissue declaration states that the error arose without deceptive intention. The previous examiner erred in arguing that appellant's "failure to stop the reissue of 'defective reissue patent RE 38,428' is factual evidence that there was no error without deceptive intention." Once again that was the fact pattern in *Luu* but does not apply to the present application. The previous argument/rationale set forth in the Final Rejection on this point has been withdrawn.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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